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EXAMINER  
CAUDLE, P

ART UNIT	PAPER NUMBER
2765	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/882,197**

Applicant(s)  
**Greer et al**

Examiner  
**Penny Caudle**

Group Art Unit  
**2765**



☒ Responsive to communication(s) filed on Jan 12, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

~~Notice of References Cited, PTO-892~~

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☒ *Notice of References cited*

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. In response to the Amendment filed on January 12, 1999, claims 1-20 have been examined. Claims 1-4, 6-9, 14 and 15 have been amended and claims 16-20 have been added.

#### ***Claim Objections***

2. Claim 20 is objected to because of the following informalities: the phrase "the plurality of keys" lacks proper antecedent basis and should either read "a plurality of keys" or the dependency should be on claim 19 instead of 18. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al (U.S. 5,796,952).

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As per claim 1, Davis et al discloses an advertising system comprising the following:

- a content provider which generates ad banners, as shown in Figure 6 (Server B);
- a target computer which receives the ad banners, as shown in Figure 6 (Client);
- an agent which is transmitted from the content provider to the target computer, the agent obtains user information including data for a hardware profile and transmits the user information to the content provider, as stated in column 4 lines 37-63, "...a tracking program is embedded in a file which is downloaded from a server to a client...and runs on the client to monitor various indicia...in order to track the user's interaction with and use...After monitoring the user's interaction with and use...the tracking program then automatically sends the information acquired from the client back to the server for storage and analysis..." and column 9 lines 41-45, "...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.";

- a program running on the content provider, the program organizes the user information and updates a user specific database as stated in column 4 lines 64-67, "The acquired information is preferably stored on a server and used to build historical profiles of individual users, to serve out highly targeted information based upon user profiles..."

As per claim 2, Davis et al disclose all the limitations as set forth in claim 1 above with the addition of the user information further includes data for a software profile. As stated in column 4 lines 64-67, "The acquired information is preferably stored on a server and used to

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build historical profiles of individual users, to serve out highly targeted information based upon user profiles...”

As per claim 3, Davis et al disclose all the limitations as set forth in claim 1 above with the addition of further comprising a user profile including the hardware profile which is updated by the program running on the contact provider. As shown in Figure 6 items S603A and S611A and stated in column 18 lines 34-37, “...the client profile is created automatically using information acquired by the tracking program and one or more CGI scripts and is stored in the server database...” and 9 lines 41-45, “...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.”.

As per claim 4, Davis et al disclose all the limitations as set forth in claim 1 above with the addition of the user profile including information on CPU processing speed. As stated in column 9 lines 41-45, “...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.”.

As per claim 5, Davis et al disclose all the limitations as discussed in paragraph 3 or paper number 2.

As per claim 6, Davis et al disclose all the limitations as set forth in claim 1 above with the addition of the user profile including a subkey indicating a processor speed of a processor in the target computer. As stated in column 9 lines 41-45, “...other information concerning the

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client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.”.

As per claim 7, Davis et al disclose a method of communicating advertising information comprising the following:

- creating a user profile, as stated in column 4 lines 64-65, “The required information is preferably stored on a server and used to build historical profiles of individual users...”;

- transmitting an ad banner from a content provider to a target computer, as stated in column 13 lines 54-56, “In the case of a Web page provided with an ad banner, the tracking program...”;

- collecting user information at the target computer including data for a hardware profile, as stated in column 4 lines 46-51, “The tracking program...and runs on the client to monitor various indicia...” and in column 9 lines 41-45, “...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.”;

- transmitting the user information from the target computer to the content provider, as stated in column 4 lines 56-59, “After monitoring the user’s interaction with and use...the tracking program then automatically sends the information acquired from the client back to the server for storage and analysis...”;

- filtering the user information to create relevant data, as stated in column 14 lines 47-48, “The tracked information may be used to assemble resources geared toward the user’s interest.”;

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-arranging the relevant data to create a modified user specific database, as stated in column 16 lines 5-9, "A second database that may be created is indexable by individual client, and includes information concerning individual client's interests and preferences...";

-generating a second user ad banner corresponding to the modified user specific database, as stated in column 15 lines 3-5, "Since the user has previously expressed a greater interest in sports, sports-related advertisements may therefore be targeted to that user."

As per claims 8-13, Davis et al disclose all the limitations as discussed in paragraph 3 of paper number 2.

As per claim 15, Davis et al disclose an advertising system comprising the following:

-a content provider which generates a means for advertising, as shown in Figure 6 (Server B);

-a target computer which receives the means for advertising, as shown in Figure 6 (Client);

-a means for obtaining user information including hardware data for a hardware profile and software data for a software profile, and transmitting the user information to the content provider, the means for obtaining user information transmitted from the content provider to the target computer, as stated in column 4 lines 37-63, "...a tracking program is embedded in a file which is downloaded from a server to a client...and runs on the client to monitor various indicia...in order to track the user's interaction with and use...After monitoring the user's interaction with and use...the tracking program then automatically sends the information acquired

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from the client back to the server for storage and analysis...” and in column 9 lines 41-45, “...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.”;

-a means for organizing the user information and upgrading a user specific database, as stated in column 4 lines 64-67, “The acquired information is preferably stored on a server and used to build historical profiles of individual users, to serve out highly targeted information based upon user profiles...”.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al (U.S. 5,794,210) in view of Davis et al (U.S. 5,796,952).

As per claim 14, Goldhaber et al disclose a content provider for providing advertising over a network comprising the following:



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-a plurality of user profiles, each user profile including user data corresponding to a target computer account, as shown in Figure 7 item 124 and stated in column 13 lines 34, "We keep a personal profile for each of our members";

-a munging agent which updates each user profile based on data transmitted from an agent, as shown in Figure 11A items 190 and 192;

-a rule set associated with each user profile including rules generated from the user data and a rulebook which selects data to be transmitted from an advertising content database using the rule set, as stated in column 15 lines 31-47, "Matching of interest profiles 124 with ads can be performed using "relevance indexing"...".

Goldhaber et al fail to disclose that the rulebook includes condition-action pairs. However, Davis et al disclose an advertising system consisting of user profiles which are used to generate user specific advertisements based on logical rules. As stated in column 14 lines 62-65, "...a user profile database may be used to determine which of the resources is to be downloaded to that client using simple logical processing instructions.". Therefore it would have been obvious at the time of the applicant's invention to implement the system taught by Goldhaber et al with the use of condition-action pairs, i.e. logical if-then instructions, as taught by Davis et al in order to provide the user with the most relevant advertising for their particular hardware and interest.

As per claim 16, Goldhaber et al and Davis et al disclose all the limitations as set forth in claim 14 above. In addition Davis et al discloses a condition-action pair includes a hardware characteristic of a target computer associated with the target computer account. As stated in

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column 9 lines 41-45, "...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.". Therefore, it would have been obvious at the time of the applicant's invention to implement the system taught by Goldhaber et al with the use of hardware profiles, as taught by Davis et al in order to provide the user with the most relevant advertising for their particular hardware and interest.

As per claim 17, Goldhaber et al and Davis et al disclose all the limitations as set forth in claim 16 above. Goldhaber et al and Davis et al fail to disclose that the hardware characteristic is a modem speed. Official Notice is given that the use of modem speed in hardware profiles for directing user specific advertising to users is old and well known in the art, as evidenced by the Newswire article "C/NET: The Computer Network Unveils Revolutionary Internet Advertising Tools that Allow Custom Banner Ad Delivery Based on Demographic Information". Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the system taught by Goldhaber et al and Davis et al with the addition of modem speed as a hardware characteristic in order to the user with the most relevant advertising for their particular interest and hardware.

As per claim 18, Goldhaber et al and Davis et al disclose all the limitations as set forth in claim 16 above. In addition Davis et al disclose when the hardware characteristic satisfies a first condition, high fidelity ad content is transmitted, and when the hardware characteristic satisfies a second condition, lower fidelity ad content is transmitted. As stated in column 15 lines 33-36,

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“...and the previously constructed historical database profile (S607B), different information (images, sounds, text, etc.) May be returned to the applet.”. Therefore, it would have been obvious at the time of the applicant’s invention to implement the system taught by Goldhaber et al with the use of hardware profiles, as taught by Davis et al in order to provide the user with the most relevant advertising for their particular hardware and interest.

As per claim 19, Goldhaber et al and Davis et al disclose all the limitations as set forth in claim 14 above. In addition Davis et al discloses the user profile includes at least one rule page including a plurality of keys, the plurality of keys includes a hardware profile to indicate hardware capabilities of a target computer associated with the target computer account. As stated in column 9 lines 41-45, “...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.”. Therefore , it would have been obvious at the time of the applicant’s invention to implement the system taught by Goldhaber et al with the use of hardware profiles, as taught by Davis et al in order to provide the user with the most relevant advertising for their particular hardware and interest.

As per claim 20, Goldhaber et al and Davis et al disclose all the limitations as set forth in claim 18 above. Goldhaber et al and Davis et al fail to disclose that the plurality of keys includes a software profile to indicate software used by the target computer account. Official Notice is given that the inclusion of software used in user profiles is old and well known in the art, as evidenced by the Newswire article “C/NET: The Computer Network Unveils Revolutionary

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Internet Advertising Tools that Allow Custom Banner Ad Delivery Based on Demographic Information". Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the system taught by Goldhaber et al and Davis et al with the addition of software profiles in order to the user with the most relevant advertising for their particular interest and hardware.

### *Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Penny Caudle whose telephone number is (703) 305-0756. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



plc

March 1, 1999

ALLEN R. MACDONALD  
SUPERVISORY PATENT EXAMINER  
*Allen R. MacDonald*